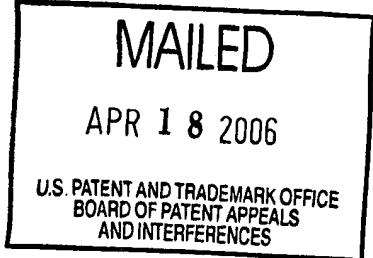


The opinion in support of the remand being entered today is *not* binding precedent of the Board.

Paper No. 19

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



*Ex parte* JACK H. HETHERINGTON

Appeal No. 2005-0367  
Application No. 09/684,205

### ON BRIEF

Before HAIRSTON, BARRY, and LEVY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-3, 5-12 and 14-26. The appellant appealed to the Board of Patent Appeals and Interferences ("Board"). We affirmed-in-part.

*Ex parte Hetherington*, Appeal No. 2005-0367, at 1 (Bd.Pat.App. & Int. June 22, 2005).

The appellant then appealed to U.S. Court of Appeals for the Federal Circuit ("Federal Circuit"). Before the appeal was decided by the Federal Circuit, however, the appellant and the Director of the United States Patent and Trademark Office ("PTO") jointly moved for a remand to the PTO "for continued prosecution of the [instant] patent application. . . ." (Paper No. 18.) The Federal Circuit granted the motion, (*id.*)

remanding the appeal to the Board. We, in turn, remand the appeal to the patent examiner for continued prosecution of the patent application.

#### ADDITIONAL OBSERVATIONS

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembicza*k, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Such a motivation "may be found in explicit or implicit teachings within . . . references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)).

Here, the examiner had provided detailed reasons for combining the teachings of U.S. Patent No. 6,304,091 ("Shahoian") and U.S. Patent No. 5,576,704 ("Baker I") to provide stationary capacitive plates and a movable dielectric. Among these reasons was his finding that "providing the Shahoian signal detecting capacitor plate being stationary would prevent a broken connection between the power source (58) and the Shahoian signal detecting capacitor plate." (Examiner's Answer at 11.) Observing that

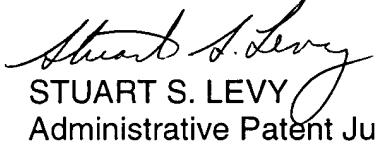
Figure 3a of Shahoian shows a connection between capacitive plate 56 and ground 58, we agreed with the examiner's finding that if the plate were stationary rather than movable, the connection would be less likely to break. *Hetherington*, at 13.

Since our original decision, the teachings of U.S. Patent No. 5,418,468 ("Baker II") have come to our attention. Baker II supports the examiner's finding that a movable plate would be subject to breakage. The reference generally discloses that "existing capacitive sensor technology has several drawbacks." Col. 1, ll. 47-48 (copy attached). Noting that "such capacitive sensors utilize moving electrically conductive elements to give positional information," *id.* at 48-50, Baker II evidences that "the moving elements tend to cause poor sensor reliability because the movement weakens the electrical connections." *Id.* at ll. 50-52. Furthermore, the reference discloses that "the moving elements also introduce unwanted 'noise' to the control system." *Id.* at ll. 52-54.

REMAND

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

  
LANCE LEONARD BARRY  
Administrative Patent Judge

  
STUART S. LEVY  
Administrative Patent Judge

) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)

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